

Remarks

Claims 1, 14, and 17-76 will be pending upon entry of this amendment.

Claims 2-13, and 15-16 have been canceled without prejudice or disclaimer. Thus, no new matter has been added by way of amendment.

The Restriction Requirement

The Examiner has required an election under 35 U.S.C. § 121 of one of the following groups:

- I. Claims 1-13, drawn to nucleic acids, vectors, host cells, and methods of expressing proteins.
- II. Claims 14-16, drawn to polypeptides.
- III. Claim 17, drawn to hHSP antagonists.
- IV. Claim 18, drawn to hHSP agonists.
- V. Claim 19, drawn to methods of treatment using polypeptide.
- VI. Claim 20, drawn to methods of treatment using DNA.
- VII. Claim 21, drawn to methods of treatment using an hHSP antagonist.
- VIII. Claim 22, drawn to a diagnostic method involving detecting a mutation in a nucleic acid.
- IX. Claim 23, drawn to a diagnostic method involving detection of a protein.
- X. Claim 24, drawn to a method of identifying agonists or antagonists of hHSP.
- XI. Claims 25-41, 44-67, and 70-76, drawn to antibodies.
- XII. Claims 42, 43, 68, and 69, drawn to immunoassays.

(See, Paper No. 4 at page 2). The Examiner contends that the inventions are distinct, each from the other.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the invention of group XI, including claims 25-41, 44-67, and 70-76, drawn to antibodies. Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should the restriction requirement be made final. In such case, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Furthermore, since the claims of Groups XI (antibodies) and XII (methods of detection using antibodies) are related as between a product and a process for using the product, and the

process claims include all the limitations of the product, the Examiner in any case would be obligated to rejoin the method claims if the elected product claims are found allowable. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. See 1184 OG 86 (March 26, 1996). Specifically, the notice states that "in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim." *Id.* Accordingly, Applicants respectfully request that if any of the antibody claims of Group XI are found allowable, the process claims of Group XII be rejoined and examined for patentability.

Applicants respectfully traverse and request the withdrawal of the Restriction Requirement. As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

See, M.P.E.P. § 803 at 800-[3-4]. Thus, even assuming, *arguendo*, that the 12 groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of multiple groups would entail a "serious burden." *Id.* In the present situation, no such showing has been made.

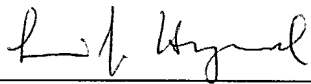
Thus, in view of M.P.E.P. § 803, the claims of all of groups I-XII should be searched and examined in the subject application. Applicants submit that a search of the subject matter of group I would provide useful information for the subject matter of the other groups. Indeed, since the different groups are directed to related sequences (SEQ ID NOS:1 and 2), a search of each of the groups would largely, if not entirely, overlap. Thus, since the searches for the polynucleotides of group I, the polypeptides of group II, the antibodies of group XI, methods of treatment of groups V-VII, methods of diagnosis of groups VIII, IX, and XII, and methods of identifying compounds and activities of group X would overlap, the search and examination of all these groups would not entail a serious burden. Accordingly, Applicants respectfully request that the Restriction Requirement Under 35 U.S.C. § 121 be withdrawn and the instant claims be examined in one application.

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

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Respectfully submitted,

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